

## REMARKS/ARGUMENTS

Claims 1-20, 35-40, and 42 have been cancelled.

Claims 21-34, 41, 43-44 remain in this application, of which claims 21, 27, 31, and 43 are independent.

Claims 21, 27, 31, and 43 have been amended.

### **Specification**

Examiner objected to the amendment filed on October 21, 2005 because it allegedly introduced new matter. Specifically, the Examiner did not find support in the original disclosure for spheres of different sizes in claim 25. The applicant respectfully disagrees.

Specification teaches that game pieces may be of different shapes. Inherent in that disclosure is that game pieces may be of different sizes. It is also well known in the game of marbles that the marbles, which are spheres, may be of different sizes. For example, an attached printout from a marble selling website, LandOfMarbles.com, lists marbles of at least three different sizes: pee-wee, shooter, and regular. Thus, as understood by one skilled in the art, the original disclosure supports spheres of different sizes in claim 25.

### **35 U.S.C. 101 and 112**

Method claim 27 was rejected under 35 USC 101 for not setting forth any steps involved in the use of visible figures.

Claim 27 has been amended to better define and distinctly claim the applicant's invention.

The amended claim 27 associates the indicia with the visible figures of the respective ones of the plurality of spheres (*see* step (b)) and uses the indicia associated with the visible figure of at least one sphere to determine an outcome (*see* step (g)). As a result, the visible figures are a factor in the step that determines the outcome. Support for the amended claim 27 can be found, for example, in the original claims 1-20, the disclosure of which was incorporated into the specification as paragraphs 0011.1-0011.22 by the amendment dated October 17, 2005. Because the use of the visible figures is tied to the claimed method steps, it is believed that the rejection under 35 U.S.C. 101 has been overcome.

Claim 27 was also rejected under 35 USC 112 “as being incomplete for omitting essential elements”, citing MPEP 2172.01. Specifically, the Examiner argued that a substrate on which indicia in claim 27 is placed was an essential element of the claim.

Applicant respectfully disagrees with the Examiner’s position. The specific structure or substrate that the indicia is placed on is not an essential element of the method claim. While indicia may be placed on, for example, a card as in claim 43, one skilled in the art would understand that it could also be displayed on other substrates, such as liquid crystal displays, the spheres, or the visible figures themselves. Thus, it is the information provided by the indicia, not the substrate, that is relevant to the present invention.

However, to address Examiner’s concern, applicant amended claim 27 to recite a generic term “substrate,” which is meant to apply to any underlying structure that carries indicia without limiting the scope of the claimed invention.

### **35 U.S.C. 103**

Claims 21-30, 32-34, and 43 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,581,932 to Jacobs (“Jacobs”).

Independent claims 21, 27 and 43 have been amended to recite “a plurality of *striking* spheres” to clearly indicate that at least two spheres are designed to strike one another during the game. Accordingly, the claimed spheres are not merely passive placeholders, but are game elements with a specific shape that allows the spheres to be rolled into each other. Thus, both the “striking” and “spherical” characteristics of the applicant’s game pieces are not merely aesthetic, but provide specific utility.

While Examiner agrees that Jacobs does not teach spherical game pieces, examiner takes the position that it would have been obvious to use spheres. (See pages 4-7 of the Office Action.) Applicant disagrees. Jacobs uses game pieces (e.g., fighter piece 18 in Figure 1) as place holders for the different positions on the game board. Jacobs’s game pieces are moved into different positions on the game board based on a roll of a die (see, *e.g.*, Jacobs col.3:49-54). The game pieces themselves are not rolled on the game board. Jacobs’s game board has three levels, making it uneven. Because Jacobs’s game board is uneven, it does not lend itself to rolling of

the game pieces. Therefore, one skilled in the art would have *no reason to use* spherical game pieces in Jacobs's game. Moreover, because spherical game pieces could roll off their intended positions on Jacobs's uneven game board, one skilled in the art *would not use* them as place holders in Jacobs's game. In fact, as can be seen in Figure 1 of Jacobs, his game piece has a flat base that prevents the game piece from rolling.

Furthermore, Jacobs's game pieces are never struck against each other. While Examiner argues that Jacobs's battle between game pieces "is inherently understood as two game pieces coming physically in contact with each other" (page 6 of the Office Action), there is nothing in Jacobs's patent to support this argument. In fact, Jacobs teaches that a fighter piece cannot be placed in a position occupied by another fighter piece unless they battle for the position. (Jacobs col.4:61-64). However, Jacobs's battle does not involve physical striking between the two game pieces, but involves a roll of the die instead. (Jacobs col.5:53-67). Accordingly, Jacobs neither teaches nor suggests, and one skilled in the art would have no reason to use, applicant's "striking spheres" in Jacobs's game.

Because one skilled in the art would not use "striking spheres" as game pieces in Jacobs's game, applicant's invention is not obvious over Jacobs. Accordingly, claims 21, 27, and 43 are patentable over Jacobs.

Claims 22-26; 28-30, 32-34, 41; and 44 are dependent on independent claims 21; 27, and 43, respectively, and are allowable at least based on their dependency.

### **Allowable Claim 31**

Applicant thanks the Examiner for indicating that the subject matter of claim 31 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2<sup>nd</sup> paragraph and to include all of the limitations of the base claim and any intervening claims. Claim 31 has been amended to incorporate the limitations of the previously presented base claim 27, and to overcome the rejections under 35 U.S.C. 112, 2<sup>nd</sup> paragraph concerning the visible figure and the substrate issues.

### 35 U.S.C. 102

Claims 35-40 and 41-42 stand rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,372,366 to Gohlke.

Applicant notes that the pending claim 41 does not depend on claim 35, but depends on the amended claim 27 instead. As discussed on page 8 of this amendment, claim 41 is allowable at least based on its dependency on the allowable claim 27.

Applicant also respectfully disagrees with Examiner's characterization of the Gohlke reference and Gohlke's alleged anticipation of the claims. Nonetheless, to advance the application to issue sooner, Applicant cancelled claims 35-40 and 42. However, Applicant expressly reserves the right to argue patentability of these seven claims over Gohlke in a continuation application.

### Conclusion

Applicant submits that all the pending claims are in condition for allowance, which action is respectfully requested.

Respectfully submitted,

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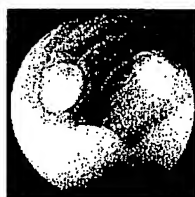


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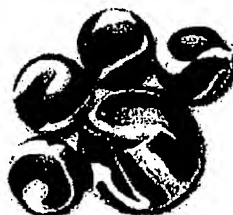
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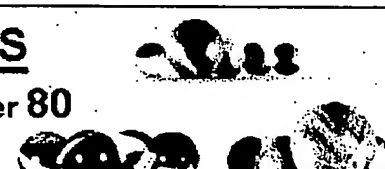
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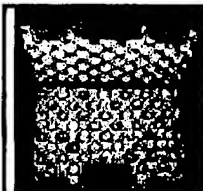
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